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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
50277-1774

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On February 20, 2007Signature Darci SakamotoTyped or printed name Darci SakamotoApplication Number
10/006,543Filed
November 30, 2001First Named Inventor
Rae K. BurnsArt Unit
2164Examiner
Wong, L.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

X

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Remarks (3 pages)

I am the

 applicant/inventor.

Signature

 assignee of record of the entire interest.See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96) attorney or agent of record.Registration number 57,181

Daniel D. Ledesma

Typed or printed name

 attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

408/414-1080

Telephone number

February 20, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below*.

 *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REMARKS

As will be seen from the discussion below, there is a clear error (1) with respect to the Examiner's assertion that the Declaration under 37 C.F.R. § 1.131 mailed May 11, 2006 is insufficient, and (2) with respect to the Examiner's inclusion of evidence that was not in the record.

The Final Office Action quotes two paragraphs of MPEP § 715.07 that state (1) that a general allegation that the invention was completed prior to the date of the cited reference is insufficient and (2) that a statement of facts are required. By quoting the paragraphs, the Final Office Action alleges that a statement of facts is not included in the Declaration, **which is clearly untrue**. The Final Office Action then requests the Applicants to "specifically point out or map particular portions of the Exhibit and dates that correspond to specific limitations of the claims in the Applicant submitted Declaration Under 37 C.F.R. § 1.131" (Final Office Action, page 3). It is respectfully noted that **neither the CFR nor the MPEP** requires that an Applicant specifically point out or map particular portions of an exhibit and dates that correspond to specific limitations of the claims.

Indeed, MPEP § 715.07 begins by stating, "The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration" (emphasis added). Therefore, exhibits are not required, yet the Final Office Action is requiring the Applicants to specifically point out or map particular portions of the Exhibits and dates, that correspond to specific limitations of the claims, in the Declaration. Nevertheless, the Applicants have done more than they are legally required to do by not only submitting multiple exhibits, but

also by annotating one of the exhibits (Exhibit D) in order to map particular portions of the test script log file with certain claim limitations.

Furthermore, MPEP § 715.07 also states, “**An accompanying exhibit need not support all claimed limitations**, provided that any missing limitation is supported by the declaration itself.” Exhibits A-D are either test script files or test script log files that show results of running the corresponding test script. The Exhibits do not provide the actual code and therefore it is not possible to show, via the Exhibits, certain features of the claims, such as the step of “determining which policies” and “determining whether to perform the operation” as recited in Claim 1. However, the CFR and MPEP **do not require code to be submitted** in an exhibit, nor do the CFR and MPEP require a declaration to state word-for-word each claim limitation. To require a declaration to state word-for-word each claim limitation would be mere form over substance since Applicants may simply recite each claim limitation and state that such claim limitation was implemented before a certain date. Nevertheless, the **inventors have done effectively as much when referring** (1) specifically to Claims 1-5 and 21-25 in statements 2, 3, 4, and 9 of the Declaration and (2) implicitly in the remaining statements. Contrary to the assertion in the Final Office Action, the Applicants have given “a clear explanation of the exhibits [in the Declaration] pointing out exactly what facts are established and relied on by applicant.” MPEP § 715.07.

Therefore, it is respectfully submitted that the Declaration and the accompanying exhibits are sufficient and that the Final Office Action erred in requiring the Applicants to specifically point out or map particular portions of the exhibits and dates that correspond to specific limitations of the claims. Accordingly, Applicants respectfully request that the rejection of Claims 1-5 and 21-25 be reversed.

Claims 6-20 and 26-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,859,966 (“Hayman”) in view of Ayi. Therefore, because the Declaration is sufficient to overcome Ayi, Applicants respectfully request that the rejection of Claims 6-20 and 26-40 also be reversed.

Additionally, the Examiner relied on evidence that was not in the record, which constitutes clear error. Administrative law and the MPEP require that all evidence of fact be made in the record. However, in the telephone interview conducted on September 8, 2006, the Examiner stated that she relied on **another Examiner’s assertion** that error conditions cited in the test script log files of Exhibits B and D are evidence that the Applicants did not possess the invention before the date in question. Furthermore, the Final Office Action’s statement (on page 12) that the USPTO “is not a court of law” is additional support that the Examiner is **not constrained** to considering only evidence that is in the record.

Based on the foregoing, Applicants respectfully request that the rejection of Claims 1-40 be reversed.